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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/993,616

11/27/2001

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EXAMINER

KESACK, DANIEL

ART UNIT

PAPER NUMBER

3691

MAIL DATE

DELIVERY MODE

03/03/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/993,616

**Applicant(s)**

AKUTSU ET AL.

**Examiner**

Daniel Kesack

**Art Unit**

3691

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 November 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 11-33 is/are pending in the application.  
4a) Of the above claim(s) 20-25 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-9, 11-19 and 26-33 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 20, 2008 has been entered.

### ***Status of Claims***

2. Claims 1-9, 11-33 are currently pending. Claims 20-25 are withdrawn from consideration. The rejections are as stated below.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-3, 26, 27, 29, 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Atlas ATM website, as retrieved from the Wayback Machine ([www.archive.org](http://www.archive.org)) from April 21, 2001, hereinafter *Atlas*, in view of Chen et al., U.S. Patent No. 6,195,694.

Claims 1, 26, 27, 29, 31-33, *Atlas* discloses determining an ATM placement fee which is to be paid to the fee recipient entity, based on electronic history information obtained from said ATM. *Atlas* discloses sending a commission check wherein the commission is a function of the number of transactions being performed on said ATM. The amount of the commission check is therefore inherently based on electronic transaction history obtained from the ATM, and therefore the electronic transaction history information is inherently obtained from the ATM in order to calculate said commission. *Atlas* further discloses that the ATM is installed in a nonblank location, and is under a payment-by-results contract.

Atlas fails to teach the electronic history information includes a browsing history containing browsing web contents that provide benefits to the service provider on the internet as the ATM has been used by an individual customer.

Chen discloses a server system for configuring kiosks, wherein an ATM is recognized as a type of kiosk (column 1 lines 41-44), wherein the kiosk is connected to the Internet (abstract), and wherein the operator of the kiosk receives payment from a service provider, such as a bank, when a user operates the kiosk to perform a web browsing function the benefits the service provider, and wherein the payment may be based on the time or duration that the information is provided by the kiosk (column 6 lines 45-55). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Atlas to include the teachings of Chen because Chen discloses additional features that can be implemented into an ATM, such as the ATM disclosed by Atlas, and the additional features provide extra revenue for the operator of the ATM, which is what the Atlas reference is concerned with as well.

Examiner respectfully points out that the newly added recitations of the independent claims are mostly regarded as intended use recitations, and are not given weight in determining patentability over the prior art. The claims recite a method comprising obtaining electronic history information, and determining the ATM placement fee based on the electronic history information. As cited above, Atlas and Chen teach these limitations. Furthermore, the prior art even teaches the fee being based on a

browsing of web contents, as cited above. Since the claim merely recites that the ATM placement fee is based on electronic history information, the fact that the electronic history information "includes" browsing information does not mean that the placement fee must be based on such information. Since "includes" is an open ended transitional phrase, it is clear that the electronic history information could also include any of the access, browsing, or usage information as disclosed in the specification. In the case where the electronic history information includes both the usage information and the browsing information, and the fee is based on the usage information, then it would be accurate to say that the fee is based on the electronic history information, even though the browsing information may not be taken into consideration. As such, the recitation of other types of information which may be in the electronic history information, but which are not used to calculate the fee, and are therefore not pertinent to the claimed method, are regarded as intended use. Furthermore, the fact that the browsing information contains beneficial browsing history, where the beneficial browsing accompanied a payment by a customer for a transaction with a credit card issued by the financial institution that installed the ATM, does not appear to further limit the claimed method because such a recitation does not affect the steps of the claimed method. Therefore, the limitations are considered non-functional as well.

Claims 2, 3, Atlas discloses the electronic transaction history information is a transaction history about the transactions performed on the ATM, wherein the

transaction history is defined in terms of the number of transactions that have been performed on the ATM.

6. Claims 4-9, 11-19, 28, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atlas and Chen, in view of Steinmetz et al., U.S. Patent No. 6,672,505.

Atlas fails to teach the electronic history information being the total sum of money that has been transacted on the ATM, the total length of time during which the ATM has been kept in proper condition for service.

Steinmetz discloses an automated banking machine configuration system and method, wherein an ATM license authority communicates with an ATM through a communications network (figure 1), and wherein the license authority collects data on ATMs and keeps track of the operation and use in order to properly assess licensing and support fees, wherein the data collected comprises functions performed, the time of operation, and the number of transactions conducted, and other data or combinations thereof (column 15 lines 61 – column 16 line 20). While Steinmetz does not explicitly mention a total sum of money transacted, one of ordinary skill in the art can appreciate that it would be obvious to keep track of this number within an ATM, and that the total sum of money may be considered “other data” as taught by Steinmetz. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Atlas and Chen to include determining the commission fee

based on said data because one who is looking for metrics on which to base such a commission would be motivated to look to the data which is commonly collected from an ATM remotely by a licensing authority, and would readily contemplate any combination of said data.

Claims 11-19, Atlas, Chen, and Steinmetz fail to teach the electronic history is a combination of transaction history and browsing history.

As cited above, Chen teaches the various aspects of a placement fee based on browsing history, and Steinmetz and Atlas teach the various aspects of a placement fee based on transaction history. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Atlas, Chen, and Steinmetz to include any combination of known methods for deriving a placement fee, because the more functions the ATM contains, the more likely a customer is to use the ATM, and the more revenue an ATM operator can receive, the more likely the operator is to desire multiple functions in the ATM, and therefore all parties involved benefit from the combination of features.

### ***Response to Arguments***

7. Applicant's arguments filed October 24, 2008 have been fully considered but they are not persuasive.



The prior art of record teaches the claimed invention, given its broadest reasonable interpretation, as described above, with regards to claims 1, 26, 27, 29, 31-33.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Kesack whose telephone number is (571)272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted,

Daniel Kesack  
March 1, 2009  
/D. K./  
Examiner, Art Unit 3691

/Hani M. Kazimi/  
Primary Examiner, Art Unit 3691